# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/821,794 | 03/30/2001 | Nobuyuki Shimamoto | 010296 | 4995 |

38834          7590          09/08/2004

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| EXAMINER |
|---|
| BAUTISTA, XIOMARA L |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2179 | |

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

| | Application No. | Applicant(s) |
| **Office Action Summary** | 09/821,794 | SHIMAMOTO ET AL. |
| | Examiner | Art Unit | |
| | X L Bautista | 2179 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>04 June 2004</u>.

2a)☒ This action is **FINAL.**       2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>12-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>12-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### Response to Arguments

1.      Applicant's arguments filed 04 June 2004 have been fully considered but they are

not persuasive.

A.      Applicant argues that "Bayer fails to disclose or fairly suggest [the]...features of

independent claims 12 and 13...Bayer fails to disclose controlling organizations,

receiving a request from a user, selecting one of the controlling organizations

corresponding to the user and sending a GUI screen of the selected controlling

organization."

In response, Bayer discloses a system having a network server providing an

addressable site on a network that generates surveys, which are transmitted over the

network to the computers of voters in their preferred language, and sends summaries

showing the results of the survey in the voter's country or the results of the survey in

other countries.  The system enables voters to register with the system at another site

on the network.  Voters are allowed to view the results of the survey (col. 1, lines 7-23;

col. 2, lines 33-54).  Bayer teaches an add voting campaign page (GUI screen,

controlling organization), wherein the network server automatically creates a unique

URL for the new voting campaign, such that a voting campaign is accessed by a voter

by requesting a connection (request from a user) to the network server (col. 12, lines 1-

10).

B.      Applicant argues that "the browser of the network client computer 18, the records

of the Registration Data table 193; and the Languages table 173 of Bayer each fail to store addresses for a plurality of GUI screens corresponding respectively to a plurality of controlling organizations for distributed control of users; and upon receiving a service request from a client system of a user, as called for in each of independent claims 12 and 13."

In response, Bayer teaches that in response to a computer of a voter connecting to the network server over the network, the network server determines the language and country of the voter. Bayer teaches that the survey is transmitted in a survey form page to the voter's computer, which enables the voter to answer each question and to submit such answers back to the network (abstract; col. 2, lines 55-64). How is it possible for the system to send the questions to the proper user (voter) without maintaining an address list in storage? The system must store addresses for the screens (pages) corresponding to the controlling organizations for distributed control of users. Bayer also teaches that the network server does not permit voters to revote by creating, when a voter connects to the server, a Voting Digital ID identifying at least the network server, the voting campaign and the survey. The voting Digital ID is transmitted by the server to the voter's computer and stored by the browser of voter's computer as a cookie. If the voter later reconnects to the server, the server checks if any cookies of the voter's computer represent a Voting Digital ID matching the current survey for the voting campaign (col. 3, lines 24-37). Therefore, the system maintains in storage an address list of all the voters that access the system by identifying the survey and voting

campaign (voting campaign page).

### Claim Objections

2.    Claims 14 and 15 (line 2) are objected to because of the following informalities:

"are related hierarchically each other" should be changed to --are related hierarchically

to each other-- or --are related hierarchically with each other--.  Correction is required.

### Claim Rejections - 35 USC § 102

3.    The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of

1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of

2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

4.    **Claims 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated**

**by *Bayer et al* (US 6,311,190 B1).**

Claims 12 and 13:

Bayer discloses a method for providing a GUI screen to a remote user from a server system through inter-computer communications between the server system and a client system of the remote user (abstract; col. 1, lines 7-24; fig. 1). Bayer teaches that when the user accesses the server system, the system selects a preferred language on the basis of the attributes of the user. The system prepares and sends the GUI in the preferred language (abstract; col. 1, lines 7-24; col. 2, lines 34-59; col. 31, lines 19-59). Bayer teaches storing conditions for providing services for a user or group of users (people are grouped by the country of origin or by attributes), (col. 2, lines 33-59). Bayer teaches selecting conditions for providing services to users belonging to a specific group (col. 2, lines 60-67; col. 3, lines 1-36). Bayer teaches that the system stores addresses for a plurality of GUI screens corresponding to a plurality of users. When the system receives a request from the client system of a user, an address corresponding to the user is selected and a GUI screen is sent to the user in the preferred language to provide a service (abstract; col. 3, lines 2-67).

## *Claim Rejections - 35 USC § 103*

5.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**6.    Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer and Carter et al (US 5,987,506).**

Claims 14 and 15:

See claim 12. Bayer teaches a network and a plurality of users and controlling organizations but it does not teach that controlling organizations that are related hierarchically to each other. However, Carter discloses a system having distributed computer workgroups, a globally addressable storage environment that accommodates remote access and two or more interconnected computer networks (abstract; col. 4, lines. Carter teaches that the system can include a hierarchy manager for organizing the plural computers into a set of hierarchical groups (col. 17, lines 25-28). Therefore, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to modify Bayer's method of conducting surveys over a network to multiple users to include controlling organizations that are related hierarchically to each other because they can control and organize users into more specific groups so they may be provided with service based on their specific needs.

### Conclusion

7.    The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach distributed computer workgroups having computers that are organized into

a set of hierarchical groups (Carter et al); a method for storing and delivering

information over the Internet having a web browser that stores the site's content for a

set period of time when a user visits the site (Lambert et al); and a method of providing

configuration information to clients in a distributed computing system regarding network

services (Miller et al).

8.      Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

9.      Any inquiry concerning this communication or earlier communications from the

examiner should be directed to X L Bautista whose telephone number is (703) 305-

3921. The examiner can normally be reached on Monday-Thursday (8:00-18:00),

Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

10.     Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

X L Bautista
Patent Examiner
Art Unit 2179

xlb
02 September 2004